



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,822	02/22/2002	Kuniyoshi Maruyama	597/1/005	9540

23565 7590 08/13/2004

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

EXAMINER

KYLE, MICHAEL J

ART UNIT PAPER NUMBER

3676

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,822

Applicant(s)

MARUYAMA, KUNIYOSHI

Examiner

Michael J Kyle

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because it is unclear if the "person whose address is not open to the public" is the same as the "identified posted person". Examiner believes that they are the same.
2. Claim 6 is objected to because it is unclear of the "person whose address is not open to the public" is the same as the "identified posted person". Examiner believes they are the same.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima (U.S. Patent Application Publication 2003/0074265) in view of Ewing (U.S. Patent Application Publication 2002/0095928).
5. Oshima discloses a managing and charging system on an internet where a person (page 9, paragraph [0131]) whose address is not open to the public can post a message, comprising a storage unit (paragraph [0025]) for storing a mail address, application receiving means (second terminal 90, described in the abstract, lines 16-18) for receiving an application by a visitor ("giver"), confirmation means responsive to the application receiving means for confirming to the visitor, the receiver of the gift and visitor's consent to payment (page 7, paragraph [0088]), and payment processing means for processing and confirming payment completion (page 7,

Art Unit: 3676

paragraph [0088]). Oshima does not explicitly disclose means directly responsive to the payment completion for notifying the visitor of the mail address of the posted person.

6. Ewing teaches a blind gift system whereby one user can send a gift, or gifts, to another anonymous user. In one situation, a member's true full name and address information may be transmitted in directly response to a gift delivery (paragraph [0028]). This allows the users to communicate freely without having to use the gift system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Oshima as taught by Ewing, in order to allow communication outside of the electronic system. The invention resulting from this combination would then send the address of the person whose address is not known to the public to the visitor in response to the visitor sending a gift.

7. With respect to claim 2, Oshima discloses the system to includes means to initiate delivery of the gift to the identified posted person by using physical distribution means following confirmation of the payment completion (page 7, paragraph [0088]). The examiner asserts that physical (non-electronic) gift will be delivered using physical distribution means.

8. With respect to claim 6, Oshima discloses a method for operating a managing and charging system on an internet where a person (page 9, paragraph [0131]) whose address is not open to the public can post a message, comprising storing a mail address (paragraph [0025]) of an identified posted person, receiving, at the system, an application by a visitor ("giver"), utilizing the system for confirming to the visitor the receiver of the gift and visitor's consent to payment (page 7, paragraph [0088]), and utilizing payment processing means at the system for processing and confirming payment completion (page 7, paragraph [0088]). Oshima does not

Art Unit: 3676

explicitly disclose utilizing the system for notifying the visitor of the mail address of the identified posted person.

9. Ewing teaches a blind gift system whereby one user can send a gift, or gifts, to another anonymous user. In one situation, the system is utilized to notify a user of a member's true full name and address information immediately and directly in response to a gift delivery (paragraph [0028]). This allows the users to communicate freely without having to use the gift system.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Oshima as taught by Ewing, in order to allow communication outside of the electronic system. The invention resulting from this combination would then send the address of the person whose address is not known to the public to the visitor immediately and directly in response to the visitor sending a gift. Examiner asserts that because the combination of Oshima and Ewing disclose all of the claimed structure of the instant application that the combination is capable of providing the claimed function of "notifying" immediately and directly following confirmation of payment completion.

10. With respect to claim 7, Oshima discloses the system to includes means to initiate delivery of the gift to the posted person by using physical distribution means following confirmation of the payment completion (page 7, paragraph [0088]). The examiner asserts that physical (non-electronic) gift will and must be delivered using physical distribution means.

Response to Arguments

11. Applicant's arguments filed April 16, 2004, (entered with the RCE filed on June 15, 2004) have been fully considered but they are not persuasive.

Art Unit: 3676

12. Applicant argues that Oshima is directed at a basically different situation than with what applicant is concerned.

13. Examiner notes that Oshima discloses all of the claimed structure and method step of the instant application (with the exception of means responsive to the payment completion as discussed in the rejections above). Additionally, whether or not a person knows the address of another person who they desire to send a gift to is not a patentable aspect of the instant application. In other words, whether or not a person previously knows the address of another person is not an aspect of a bulletin board on the Internet, or any other electronic system. Additionally, in Oshima, a person sending the gift does not necessarily know the address of the giftee. Furthermore, Oshima provides the basic structure the allows a person to send a gift to another person regardless of whether they know the other persons address or not, as that address is stored in the computer system of Oshima. This is identical to the system presently claimed, with the exception of the address being provided to gift sender, as discussed in the rejection above.

14. Applicant traverses the conclusion that a combination of Oshima and Ewing renders applicant's invention obvious because the teaching that the examiner states as present in Ewing is not present. Applicant continues to state the paragraph cited by the examiner to show the teaching actually deal with what occurs after the gifter sends a gift to the anonymous giftee, and the system asks the giftee for instruction on whether the giftee's full name and address is to be provided to the gifter. Examiner respectfully disagrees with this interpretation of Ewing.

15. As an initial matter, examiner notes that in Ewing, the users are not necessarily anonymous, as Ewing discloses in paragraph [0053]. However, even if were true that the users

Art Unit: 3676

in Ewing were anonymous, this does not affect the teachings of Ewing the examiner cites.

Paragraph [0028] sets forth a series of initial steps and inquiries that a user goes through upon signing up for the system. These inquiries are described in paragraphs [0026-0028]. In paragraph [0028], Ewing discusses how giftee may respond in the case of receiving a gift. One of the responses includes providing the giftee's true full name and address. This is a preset and automatic option that the giftee has the choice of selecting upon initially signing up for the service. This step occurs directly and immediately after the in response to the giftor paying for a gift, and the gift being accepted. Examiner notes that in paragraph [0028], Ewing discloses the transmission of the giftee's true full name and address to be in response to a "successfully-completed blind gift delivery transactions". Examiner considers the blind gift delivery transaction occur once the gift is accepted according the giftee's preset preferences, not actually upon receipt of the gift, because delivery process will be initiated when the gift is accepted.

Conclusion

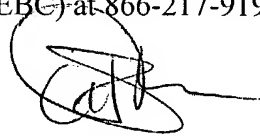
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3676

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk



Heather Shackelford
Supervisory Patent Examiner
Technology Center 3600